

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86230383
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION	
MARK FILE NAME	http://tsdr.uspto.gov/img/86230383/large
LITERAL ELEMENT	U
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_7340104251-20150710222154023526_U_and_Design_Request_for_Reconsideration.pdf
CONVERTED PDF FILE(S) (7 pages)	\\TICRS\EXPORT16\IMAGEOUT16\862\303\86230383\xml9\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\862\303\86230383\xml9\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\862\303\86230383\xml9\RFR0004.JPG
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GOODS AND/OR SERVICES SECTION (006)(no change)	
GOODS AND/OR SERVICES SECTION (009)(no change)	

GOODS AND/OR SERVICES SECTION (011)(current)	
INTERNATIONAL CLASS	011
DESCRIPTION	
Electrical and electronic installation products and accessory components, namely, fittings and supports for fluorescent lighting fixtures	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (011)(proposed)	
INTERNATIONAL CLASS	011
TRACKED TEXT DESCRIPTION	
Electrical and electronic installation products and accessory components, namely, fittings and supports for fluorescent lighting fixtures; Electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures	
FINAL DESCRIPTION	
Electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (017)(no change)	
GOODS AND/OR SERVICES SECTION (019)(no change)	
SIGNATURE SECTION	
RESPONSE SIGNATURE	/meh/
SIGNATORY'S NAME	Michael E. Hall
SIGNATORY'S POSITION	Attorney of record, Virginia bar member
SIGNATORY'S PHONE NUMBER	609-270-4918
DATE SIGNED	07/10/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jul 10 22:24:51 EDT 2015
	USPTO/RFR-73.40.104.251-2

TEAS STAMP

0150710222451315477-86230
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315f7b998cbb7a-N/A-N/A-20
150710222154023526

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86230383** U (Stylized and/or with Design, see <http://tsdr.uspto.gov/img/86230383/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Original PDF file:

[evi_7340104251-20150710222154023526 . U and Design Request for Reconsideration.pdf](#)

Converted PDF file(s) (7 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 011 for Electrical and electronic installation products and accessory components, namely, fittings and supports for fluorescent lighting fixtures

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the

applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Electrical and electronic installation products and accessory components, namely, fittings and supports for fluorescent lighting fixtures;~~ [Electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures](#)

Class 011 for Electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /meh/ Date: 07/10/2015

Signatory's Name: Michael E. Hall

Signatory's Position: Attorney of record, Virginia bar member

Signatory's Phone Number: 609-270-4918

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86230383

Internet Transmission Date: Fri Jul 10 22:24:51 EDT 2015

TEAS Stamp: USPTO/RFR-73.40.104.251-2015071022245131
5477-86230383-5302450538af74d539d641aeec
049894673cda6b79f3cd315f7b998cbb7a-N/A-N
/A-20150710222154023526



Mark:

Applicant: Unistrut International Corporation

Serial No.: 86230383

Attorney Ref.: 1532TUN04168

Request for Reconsideration

In a final Office Action dated January 10, 2015, the Examining Attorney made final the requirement to amend the identification of goods. Applicant respectfully submits the following remarks, and requests that the application be approved for publication.

For the sake of clarity, below is Applicant's current identification of goods with the portions to which the Examining Attorney has objected highlighted in **red**:

Class 6

Building and framing accessory and installation components all made of metal, namely, nuts, bolts, screws, washers for use as hardware, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe couplings, pipe clamps, pipe rollers for use as hardware, pipe hangers, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers; **structural building and framing products, namely, rolled and extruded metal sections; sectional metallic building units and couplings, fittings, and connections therefor, adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures; metal electrical and electronic installation products and accessory components, namely, cable trays and supports, conduits, bus duct and bus bar supports, cable saddles and supports, bus bar clamps, bus duct connectors, and wiring stud nuts**

Class 9

Electrical and electronic installation products and accessory components, namely, raceways, switch plates, outlets and outlet plates, conduit connection fittings and connectors, outlet box connection fittings, fibre wire retainers in the nature of reels for electrical wire, relay racks for mounting electrical equipment; printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements; electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members; electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators

Class 11

Electrical and electronic installation products and accessory components, namely, fittings and supports for fluorescent lighting fixtures

Class 17

Building and framing accessory and installation components, namely, rubber washers and plastic conduits

Class 19

Non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings, ducts, and door jambs; non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe couplings, pipe clamps, pipe rollers for use as hardware, pipe hangers, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers

Below Applicant addresses the Examining Attorney's objections one by one and by class.

Class 6

First, the Examining Attorney objected to "structural building and framing products, namely, rolled and extruded metal sections" in Class 6. Specifically, the Examining Attorney requires that "the type of 'metal section' product must be identified." Applicant notes the following entries are acceptable in Class 6 according to the ID Manual:

- "frames of metal for building"
- "frameworks of metal"
- "building wall framing made primarily of metal"

If these three entries are acceptable, then Applicant respectfully submits its "metal sections," which are stated to be "*structural building and framing products*," should likewise be acceptable.

Second, the Examining Attorney objected to "sectional metallic building units and couplings, fittings, and connections therefor, adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures" in Class 6. Specifically, the Examining Attorney stated that "the particular types of units, couplings, fittings and connections must be specified." With respect to the wording "sectional metallic building units . . . adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures," Applicant respectfully submits this wording is acceptable for the reasons stated above; in other words, this wording is at least as specific as the acceptable wording "frames of metal for building." Turning then to the "couplings, fittings, and connections therefor" – i.e., for the sectional metallic building units for framing – Applicant does not understand why such couplings, fittings, and connections would not be acceptable. For example, the following wording is acceptable according to the ID Manual:

- "metal *couplings* for fire hoses" in Class 6

- “metal *couplings* for use with hydraulic pneumatic systems” in Class 6
- “pipe *coupling* of metal” in Class 6
- “metal pipes and metal *fittings therefor*” in Class 6
- “tool and tool accessory boxes made of metal sold empty and parts and *fittings therefor*” in Class 6
- “scientific apparatus and instruments, namely, chromatography columns for use in purification in the laboratory and parts and *fittings therefor*” in Class 9
- “catheters and parts and *fittings therefor*” in Class 10
- “commercial refrigerators and freezers and parts and *fittings therefor*” in Class 11
- “marine equipment, namely, anti-surfing/broaching drogues and parts and *fittings therefor*” in Class 12
- “metal *connectors* for decking and decking joints” in Class 6
- “metal pipe *connectors*” in Class 6
- “structure joint *connectors* of metal” in Class 6
- “cable *connectors*” in Class 9
- “electric *connectors*” in Class 9

In short, if, as Applicant believes, its “sectional metallic building units . . . adapted to serve as framing and supporting members for temporary and permanent construction of buildings and other structures” are properly classified, then Applicant respectfully submits that “couplings, fittings, and connections” for such products are sufficiently definite and properly classified.

The last clause in Class 6 to which the Examining Attorney objected is “metal electrical and electronic installation products and accessory components, namely, cable trays and supports, conduits, bus duct and bus bar supports, cable saddles and supports, bus bar clamps, bus duct connectors, and wiring stud nuts.” The Examining Attorney stated this wording could include goods in other classes, i.e., “[g]oods that are conductors of electricity are in International Class 9 and metal items that are not conductors are in International Class 6.” The Examining Attorney appears to have misunderstood what these goods are; they are not conductors of electricity. They are *used with* electrical items, but they are not themselves electrical conductors or the like. For example, metal cable trays, metal conduits, metal clamps, and metal nuts are all classified in Class 6 according to the ID Manual.

Class 9

In Class 9, the first clause to which the Examining Attorney objected is “electrical and electronic installation products and accessory components, namely, raceways, switch plates, outlets and outlet plates, conduit connection fittings and connectors, outlet box connection fittings, fibre wire retainers in the nature of reels for electrical wire, relay racks for mounting electrical equipment.” The Examining Attorney writes:

Goods that are conductors of electricity are in International Class 9 and metal hardware items that are not conductors are in International Class 6, and non-metal hardware items that are not electricity conductors are in International Class 20. As currently worded the identification states that the goods are products and

accessories for installation of electrical and electronic items, but does not specify whether the goods themselves are electrical in nature.

Below Applicant compares its wording with acceptable wording in Class 9 according to the ID Manual:

Applicant's wording	ID Manual
"electrical...raceways"	"electrical raceways"
"electrical...switch plates"	"electric switch plates"
"electrical...outlets"	"electrical outlets"
"electrical...outlet plates"	"electrical outlet plates"
"electrical...conduit connection fittings and connectors"	"electrical connections" "electrical connectors" <i>(see remarks above regarding "fittings")</i>
"electrical...outlet box connection fittings"	"electrical outlets" "electrical outlet box plaster rings"
"electronic installation products and accessory components, namely,...fibre wire retainers in the nature of reels for electrical wire"	"reels for electric wire"
"electronic installation products and accessory components, namely,...relay racks for mounting electrical equipment"	"mounting devices for photographic equipment" <i>(by analogy)</i>

The second clause in Class 9 to which the Examining Attorney objected is "printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements." The Examining Attorney objects for two reasons. The first is that "it contains the open-ended wording 'including.' See TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with 'namely.'" However, with all due respect to the Examining Attorney, there is no *per se* rule that the word "including" is unacceptable. As the Board has stated, "[t]he determination of whether the term 'including' renders the identification of goods indefinite must be decided on a case-by-case basis in the context of the goods so identified." *In re Gina Marie Slattery and Kris Johnson*, Serial Nos. 78887793 and 78887799 (T.T.A.B. 2008). For example, since "furniture" is acceptable according to the ID Manual, would the Examining Attorney object to "furniture, including chairs" in Class 20?

The second reason the Examining Attorney objected to this wording is on the basis that Applicant must state "whether the items are for assembling circuit cards or component parts of circuit cards." Applicant respectfully disagrees with the Examining Attorney's objection because "printed circuit card guide assemblies including framing members, brackets, rubber-phenolic guide elements, or resin or plastic guide elements and insert elements" are simply

printed circuit card guide assemblies that include the items mentioned. The wording “printed circuits” by itself is acceptable according to the ID Manual, and there is no logical reason why adding the word “assemblies” should render it indefinite. For example, “electronic locks” and “electronic lock assemblies” are both acceptable in Class 9 according to the ID Manual.

The third and fourth clauses in Class 9 to which the Examining Attorney objected are “electricity distribution console assemblies primarily comprised of adjustable framing members adapted to installation of electronic equipment facing members” and “electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators.” The Examining Attorney writes:

Metal hardware frames, brackets and fittings that are not electric in nature are in International Class 6, electrical items that are parts of assemblies are in International Class 9, non-metal framing such poles for electric power lines and building are in International Class 19.

The wording “electricity distribution consoles” is in Class 9 according to the ID Manual, and as noted above (“electronic locks” and “electronic lock assemblies” both in Class 9), the addition of the word “assemblies” should not render it indefinite or overly broad. With all due respect to the Examining Attorney, her apparent position that metal items “not electric in nature are in International Class 6” appears too sweeping, for there are numerous goods fitting that description that are properly classified in Class 9. For example, and as noted above, “electrical raceways” and “reels for electric wire” are in Class 9. Likewise, Applicant’s “electricity distribution console assemblies...” is properly classified in Class 9. The same analysis applies to the fourth clause, namely Applicant’s “electrical substation assemblies primarily comprised of adjustable framing members, brackets, and fittings adapted for mounting of electrical insulators.”

Class 11

Applicant has deleted the wording “and supports” so that Class 11 now reads as “electrical and electronic installation products and accessory components, namely, fittings for fluorescent lighting fixtures.” Applicant respectfully submits that this amended wording is acceptable because, by analogy, “ceiling light fittings” and “incandescent lamps and their fittings” are acceptable according to the ID Manual.

Class 17

The Examining Attorney objected to the wording in this class, which, in its entirety, is “building and framing accessory and installation components, namely, rubber washers and plastic conduits.” Applicant respectfully submits that its rubber washers and plastic conduits, which are stated to be for building purposes, is acceptable. Below are the relevant screenshots from the ID Manual:

Refine Search: (RUBBER\$ WASH\$)

Return results with status: ☒ A - Added ☒ M - Modified ☒ X - Examples ☐ D

[Click here](#) for more information about Manual entry status

Documents: 1 - 2 of 2

Hit No.	Class	Description	Status	Effective Date	Type	Note	TM5
1	017	Washers of rubber for {indicate use}	A	02 Apr 91	G	N	
2	017	Washers of rubber or vulcanized fiber	A	20 Jul 04	G	N	T

017 **Plastic** tubes for {indicate use, e.g. protecting electrical wires, milking machines, etc.} [**conduits**; not packaging]

03-06-2014: Entry clarified by inclusion of examples within curly brackets and informational matter within square brackets. Tubes and pipes are generally classified by material composition when used as building materials or when their function is not otherwise mentioned in a Class Heading. Other tubes with more specific purposes are classified based on such purpose, such as glass tubes for scientific purposes in Class 9 and endotracheal tubes in Class 10, regardless of their material composition.

Class 19

The first clause in this class to which the Examining Attorney objected is “non-metal structural building and framing products, and accessory components therefor, namely, trolley and conveyor assemblies and parts, end caps and closure strips for channel and tubing members, shelf brackets, beam clamps, concrete inserts, partition and display fittings and moldings, ducts, and door jambs.” The Examining Attorney states that this wording could include goods in other classes, and gives “non-metal shelf brackets” and “beam clamps” as examples of goods in Class 20, “electrical ducts” in Class 9, “ducts for heating and ventilation” in Class 19 and “cable organization ducts” in Class 20. Applicant respectfully disagrees because Applicant’s goods are explicitly stated to be “non-metal **structural building and framing products**, and accessory components therefor, namely,…” Thus, for example, Applicant’s shelf brackets are *building* products and not, say, shelf brackets one might use in a home office. This is why Applicant’s goods are in Class 19, for which the short title is “non-metallic building materials.” In an effort to perhaps clear up the general nature of Applicant’s goods, below is a screenshot from Applicant’s catalog:

UNISTRUT® DEFENDER™

NEW



PROTECTION FROM THE HARSHTEST ENVIRONMENTS

Applicant also notes that “non-metal ducts” are in Class 19 according to the ID Manual.

Lastly, the Examining Attorney also objected to the second clause in Class 19, which is “non-metal building and framing accessory and installation components, namely, nuts, bolts, screws, studs, hinges, springs for use as hardware, spring clips for use as hardware, pipe couplings, pipe clamps, pipe rollers for use as hardware, pipe hangers, fender hooks for use as hardware, conveyor and trolley rollers for use as hardware, clamps, brackets for use as hardware, tubing clips, and conduit and pipe risers.” Applicant respectfully submits that these goods are also properly classified in Class 19, for the same reason the first clause is.

Conclusion

Having responded to all outstanding issues, Applicant respectfully requests that the application be approved for publication. The Examining Attorney is invited to contact the undersigned with any questions.